

**REMARKS**

Claims 1 and 3-31 are pending, claim 2 having been canceled.

Applicants wish to thank the Examiner for taking the time to discuss the present application and the outstanding office action during a brief telephonic discussion with the undersigned on June 29, 2005. During said discussion, the undersigned briefly summarized Applicants' then proposed responses to the various issues raised in the office action, which responses are hereinafter set forth in detail.

**Support for Amended and New Claims**

Applicants wish to point out that certain claim amendments or new claims were incorporated into the present Continuation application as filed. Applicants submit that such amendments and new claims are supported by the specification of the parent application as filed (Appln. 09/580,246; now US 6,739,333 B1), such that the present application is properly filed as a Continuation application not introducing any new matter. Support for the claim amendments and new claims are as follows:

**Claim 1:**

This claim was amended to change "comprising the following alloy forming walls of the cannister" in the preamble to read - - wherein the walls of the cannister are formed by an alloy comprising the following elements in the amounts indicated: -- . The primary distinction in this wording is the position of the transitional word "comprising", to make it clear that this is an open-ended type claim - i.e., the alloy may contain additional elements other than the specifically recited elements and still fall within the scope of the claim.

Applicants submit that this concept was clearly supported by the language used in the parent application as filed, e.g., see the parent application as filed at pg. 2, line 32 and pg. 3, line 3 where the open-ended term "contain" is used: ("The components of this alloy contain . . .") and "In another embodiment the alloy additionally contains . . ."), and also at pg. 3, line 32 ("The container (2) according to the invention is made of an alloy having a content of . . ."). Additionally, the parent application as filed makes reference to the use of the alloy "according to the material number 1.4539 of the steel-iron list of the association of German iron-works-worker" at page 4, lines 11-14. As is clear from the attached document from the

German Stahlschlüssel of 1995, 17<sup>th</sup> ed., said material number 1.4539 of this steel-iron list was known to additionally contain a trace amount of nitrogen (0.04 to 0.15%). Since this trace element was not specifically mentioned in the parent application as filed, it is clear that the Applicants intended an open-ended interpretation such that the presence of additional unrecited trace elements within the alloy is still considered within the scope of the invention.

Claim 1 was also amended to include a proviso that the alloy does not contain aluminum. Applicants submit that this concept is clearly supported throughout the parent application as filed, esp. in the Background of the Invention section (pgs 2-3) which clearly sets forth the various problems associated with aluminum-containing canisters for propellant-driven inhalers, especially the problem of corrosion in the presence of formulations, see, esp. page 2, lines 1-15. As is clear from the subsequent description at page 2, lines 18-25, the present invention is intended to provide a cannister which is corrosion-resistant in the presence of active substance formulations. Thus, it is clear that Applicants never intended to cover a MDI cannister containing aluminum that might cause corrosion. This is further reinforced by the fact that none of the alloy examples in the application as filed mentions aluminum.

Claim 3:

This claim was added to the present application in order to specifically recite that the alloy may contain a trace amount of nitrogen in the amount of about 0.04 to about 0.15%.

Applicants submit that this concept of trace nitrogen being present is supported by the reference to the alloy of material number 1.4539 of the steel-iron list of the association of the German iron-works-worker at page 4, lines 11-14 of the application. As pointed out above, the German Stahlschlüssel of 1995, 17<sup>th</sup> ed., indicates that said material number 1.4539 of this steel-iron list was known to additionally contain a trace amount of nitrogen (0.04 to 0.15%). Applicants submit therefore, that the concept of trace nitrogen being present in the alloy of the invention was supported by the parent application as filed.

Claim 4

This claim was added to the present application to specifically claim the use of an alloy according to material number 1.4539 of the steel-iron list of the association of the German iron-works-worker. As pointed out above, the parent application as filed makes reference to the use of the alloy “according to the material number 1.4539 of the steel-iron list of the

association of German iron-works-worker” at page 4, lines 11-14. Thus, Applicants submit that claim 4 recites a concept that was present in the parent application as filed.

Claim 5

This claim was amended (from the original claim 2 of the parent application) to change “and the remainder comprises Iron” to -- and the remainder consisting essentially of Iron --. This “consisting essentially of” language is supported in the parent application as filed at page 4, lines 24-25.

Rejection Under 35 USC 112, 2<sup>nd</sup> Paragraph

Claim 4 stands rejected under 35 USC 112, 2<sup>nd</sup> paragraph, as being indefinite. The Examiner states that the Examiner does not know what exactly constitutes an alloy according to material number 1.4539 of the steel-iron list of the association of the German iron-works-worker. In response, Applicants are submitting herewith a page from the German Stahlschlüssel of 1995, 17<sup>th</sup> ed., which defines the components of said alloy according to material number 1.4539. This reference is an indication of the knowledge existing in the art at the time the present application was filed. Accordingly, Applicants respectfully submit that a person of ordinary skill in the art would understand what is meant by the language of claim 4 in view of said knowledge in the art. Therefore, withdrawal of this rejection is respectfully requested.

Double Patenting Rejection

Claims 1 and 5-30 stand rejected under 35 USC 101 as claiming the same invention as that of claims 1, 2-20, 59, 62, 65, 66, 67, 68 and 69 of prior US Patent No. 6,739,333. The Examiner further states that the recitation in the present claims of the proviso that the alloy does not contain aluminum is inherent in what is only positively recited in claim 1 of the patent.

Applicants respectfully traverse and submit that the statutory double patenting rejection under 35 USC 101 is improper. 35 USC 101 prevent two patent from issuing on the same invention. The “same invention” in this context means identical subject matter. For example, the invention defined by a claim reciting a compound having a “halogen” substituent is not identical to or substantively the same as a claim reciting the same

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compound except having a chlorine substituent in place of the halogen because “halogen” is broader than “chlorine”. *See MPEP 804 II. A. Statutory Double Patenting - 35 U.S.C. 101.* In a like manner, Applicants submit that the pending claims are broader in scope than the claims issued in the ‘333 patent and, therefore, a statutory double patenting rejection is improper.

Claim 1 of the ‘333 patent reads: “comprising the following alloy forming walls of the cannister . . .” in the preamble whereas Claim 1 of the present application reads: “wherein the walls of the cannister are formed by an alloy comprising the following elements in the amounts indicated: . . .”. The distinction in this wording is the position of the transitional word “comprising”, making it clear that Claim 1 of the present application (reciting “an alloy comprising the following elements. . .”) is an open-ended claim - i.e., the alloy may contain additional elements other than the specifically recited elements and still fall within the scope of the claim (except aluminum, of course, which is specifically excluded). By contrast, Claim 1 of the ‘333 patent does not contain the open-ended transitional word “comprising” following the word “alloy”. For this reason, Claim 1 of the present application is clearly broader in scope than Claim 1 of the ‘333 patent.

Furthermore, Claim 5 of the present application contains the partially open transitional phrase “consisting essentially of” at the end of the claim: “and the remainder consisting essentially of Iron” which phrase is entirely absent from the corresponding claim 2 of the ‘333 patent. For this reason, Claim 5 of the present application is clearly broader in scope than Claim 2 of the ‘333 patent.

Since all the other pending claims in the present application depend, either directly or indirectly, from Claim 1, they also must be considered to be broader in scope than the claims issued in the ‘333 patent.

Since the claims are of a different scope, and therefore not identical to the claims issued in the ‘333 patent, a statutory double patenting rejection under 35 USC 101 is improper. At most, the ‘333 patent might be argued to establish a basis for an obviousness type double patenting rejection. Applicants are herewith submitting an appropriately executed Terminal

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Disclaimer under 35 USC 253 and 37 CFR 1.321 to obviate any potential obviousness type double patenting rejection in order to expedite prosecution and allowance herein.

Claims Objections

Applicants appreciate the Examiner's indication of the allowable subject matter of claims 2, 3 and 31 in Section 6, page 3, of the Office Action. These claims were objected to as being dependent upon a rejected base claim. Applicants respectfully submit that the base claims are now allowable and, accordingly, this claim objection is now rendered moot.

In view of the above amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance and earnestly request such action. If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

  
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BUNDESREPUBLIK DEUTSCHLAND    REPUBLIQUE FEDERALE D'ALLEMAGNE    FEDERAL REPUBLIC OF GERMANY												
Rost- und säurebeständige Stähle			13    Aciers inoxydables			13    Stainless steels						
Stoff-Nr.	Kurzname	Analyse	Analyse								Composition	
Norme No.	Symbole Symbol		C	Si	Mn	P	S	Cr	Mo	Ni	V	Sonstige Autres - Others
Standard No.	DIN	%	≤ %	≤ %	≤ %	≤ %	%	%	%	%	%	%
1.4000	X6Cr13	≤ 0,08	1,00	1,00	0,045	0,030	12,0-14,0	-	-	-	-	-
1.4001	X7Cr14	≤ 0,08	1,00	1,00	0,045	0,030	13,0-15,0	-	-	-	-	-
1.4002	X6CrAl13	≤ 0,08	1,00	1,00	0,045	0,030	12,0-14,0	-	-	-	Al 0,10-0,30	-
1.4003	X 2 Cr 11 (X2CrNi12)	≤ 0,03	1,00	0,50-1,50	0,040	0,015	10,5-12,5	-	0,30-1,00	-	N ≤ 0,03	-
1.4005	X12CrS13	≤ 0,15	1,00	1,00	0,045	0,15-0,25	12,0-13,0	-	-	-	-	-
1.4006	X 10 Cr 13 (X12Cr13)	0,08-0,12	1,00	1,00	0,045	0,030	12,0-14,0	-	-	-	-	-
1.4016	X6Cr17	≤ 0,08	1,00	1,00	0,045	0,030	15,5-17,5	-	-	-	-	-
1.4021	X20Cr13	0,17-0,25	1,00	1,00	0,045	0,030	12,0-14,0	-	-	-	-	-
1.4024	X15Cr13	0,12-0,17	1,00	1,00	0,045	0,030	12,0-14,0	-	-	-	-	-
1.4028	X30Cr13	0,28-0,35	1,00	1,00	0,045	0,030	12,0-14,0	-	-	-	-	-
1.4031	X 38 Cr 13 (X39Cr13)	0,35-0,42	1,00	1,00	0,045	0,030	12,5-14,5	-	-	-	-	-
1.4034	X46Cr13	0,42-0,50	1,00	1,00	0,045	0,030	12,5-14,5	-	-	-	-	-
1.4057	X 20 CrNi 17 2 (X19CrNi17-2)	0,14-0,23	1,00	1,00	0,045	0,030	15,5-17,5	-	1,50-2,50	-	-	-
1.4104	X 12 CrMoS 17 (X14CrMoS17)	0,10-0,17	1,00	1,50	0,060	0,15-0,35	15,5-17,5	0,20-0,60	-	-	-	-
1.4105	X 4 CrMoS 18 (X6CrMoS17)	≤ 0,06	1,00	1,50	0,060	0,15-0,35	16,5-18,5	0,20-0,60	-	-	-	-
1.4109	X 65 CrMo 14 (X70CrMo15)	0,65-0,75	0,70	1,00	0,040	0,015 <sup>2)</sup>	13,0-15,0	0,50-0,60	-	-	-	-
1.4110	X55CrMo14	0,48-0,60	1,00	1,00	0,040	0,015	13,0-15,0	0,50-0,80	-	≤ 0,15	-	-
1.4111	X110CrMoV15	1,05-1,15	1,00	1,00	0,045	0,030	14,0-16,0	0,40-0,60	-	0,10-0,15	-	-
1.4112	X90CrMoV18	0,85-0,95	1,00	1,00	0,040	0,020	17,0-19,0	0,90-1,30	-	0,07-0,12	-	-
1.4113	X6CrMo17-1	≤ 0,08	1,00	1,00	0,045	0,030	16,0-18,0	0,90-1,30	-	-	-	-
1.4116	X 45 CrMoV 15 (X50CrMoV15)	0,42-0,50	1,00	1,00	0,045	0,030	13,8-15,0	0,45-0,60	-	0,10-0,15	-	-
1.4117	X38CrMoV15	0,35-0,40	1,00	1,00	0,045	0,030	14,0-15,0	0,40-0,60	-	0,10-0,15	-	-
1.4120	X20CrMo13	0,17-0,22	1,00	1,00	0,040	0,015	12,0-14,0	0,90-1,30	≤ 1,00	-	-	-
1.4122	X 35 CrMo 17 (X39CrMo17-1)	0,33-0,45	1,00	1,00	0,040	0,015	15,5-17,5	0,80-1,30	≤ 1,00	-	-	-
1.4125	X105CrMo17	0,95-1,20	1,00	1,00	0,040	0,020	16,0-18,0	0,40-0,80	-	-	-	-
1.4301	X 5 CrNi 18 10 (X4CrNi18-10)	≤ 0,07	1,00	2,00	0,045	0,030	17,0-19,0	-	8,50-10,5	-	-	-
1.4303	X 5 CrNi 18 12 (X4CrNi18-12)	≤ 0,07	1,00	2,00	0,045	0,030	17,0-19,0	- <sup>3)</sup>	11,0-13,0	-	-	-
1.4305	X 10 CrNiS 18 9 (X8CrNiS18-9)	≤ 0,12	1,00	2,00	0,060	0,15-0,35	17,0-19,0	- <sup>3)</sup>	8,00-10,0	-	-	-
1.4306	X2CrNi19-11	≤ 0,030	1,00	2,00	0,045	0,030	18,0-20,0	- <sup>3)</sup>	10,0-12,5	-	-	-
1.4310	X 12 CrNi 17 7 (X9CrNi18-8)	≤ 0,12	1,50	2,00	0,045	0,015	16,0-18,0	≤ 0,80	6,00-9,00	-	-	-
1.4311	X2CrNi18-10	≤ 0,030	1,00	2,00	0,045	0,030	17,0-19,0	-	8,50-11,5	-	N 0,12-0,22	-
1.4313	X 4 CrNi 13 4 (X3CrNiMo13-4)	≤ 0,05	0,60	1,00	0,035	0,015	12,5-14,0	0,40-0,70	3,50-4,50	-	N ≥ 0,020	-
1.4362	X2CrNiN23-4	≤ 0,030	1,00	2,50	0,035	0,015	21,5-24,5	≤ 0,60	3,00-5,50	-	N 0,05-0,20	-
1.4401	X 5 CrNiMo 17 12 2 (X4CrNiMo17-12-2)	≤ 0,07	1,00	2,00	0,045	0,030	16,5-18,5	2,00-2,50	10,5-13,5	-	-	-
1.4404	X 2 CrNiMo 17 13 2 (X2CrNiMo17-12-2)	≤ 0,030	1,00	2,00	0,045	0,030	16,5-18,5	2,00-2,50	11,0-14,0	-	-	-
1.4406	X 2 CrNiMoN 17 12 2 (X2CrNiMoN17-11-2)	≤ 0,030	1,00	2,00	0,045	0,030	16,5-18,5	2,00-2,50	10,5-13,5	-	N 0,12-0,22	-
1.4418	X 4 CrNiMo 16 5 (X4CrNiMo16-5-1)	≤ 0,05	1,00	1,50	0,035	0,015	15,0-16,5	0,80-1,50	4,50-6,00	-	N ≥ 0,020	-
1.4429	X2CrNiMoN17-13-3	≤ 0,030	1,00	2,00	0,045	0,025	16,5-18,5	2,50-3,00	11,5-14,5	-	N 0,14-0,22	-
1.4435	X2CrNiMo18-14-3	≤ 0,030	1,00	2,00	0,045	0,025	17,0-18,5	2,50-3,00	12,5-15,0	-	-	-
1.4436	X 5 CrNiMo 17 13 3 (X4CrNiMo17-13-3)	≤ 0,07	1,00	2,00	0,045	0,025	16,5-18,5	2,50-3,00	11,0-14,0	-	-	-
1.4438	X 2 CrNiMo 18 16 4 (X2CrNiMo18-15-4)	≤ 0,030	1,00	2,00	0,045	0,025	17,5-19,5	3,00-4,00	14,0-17,0	-	-	-
1.4439	X2CrNiMoN17-13-5	≤ 0,030	1,00	2,00	0,045	0,025	16,5-18,5	4,00-5,00	12,5-14,5	-	N 0,12-0,22	-
1.4460	X 4 CrNiMoN 27 5 2 (X3CrNiMoN27-5-2)	≤ 0,05	1,00	2,00	0,045	0,030	25,0-28,0	1,30-2,00	4,50-6,00	-	N 0,05-0,20	-
1.4462	X2CrNiMoN22-5-3	≤ 0,03	1,00	2,00	0,030	0,020	21,0-23,0	2,50-3,50	4,50-6,50	-	N 0,08-0,20	-
1.4465	X1CrNiMoN25-25-2	≤ 0,02	0,70	2,00	0,020	0,015	24,0-26,0	2,00-2,50	22,0-25,0	-	N 0,08-0,16	-
1.4505	X4NiCrMoCuNb20-18-2	≤ 0,05	1,00	2,00	0,045	0,015	16,5-18,5	2,00-2,50	19,0-21,0	-	Cu 1,80-2,20; Nb ≥ 8 x % C <sup>1)</sup>	-
1.4506	X5NiCrMoCuTi20-18	≤ 0,07	1,00	2,00	0,045	0,030	16,5-18,5	2,00-2,50	19,0-21,0	-	Cu 1,80-2,20; Ti ≥ 7 x % C	-
1.4510	X 6 CrTi 17 (X3CrTi17)	≤ 0,08	1,00	1,00	0,045	0,030	16,0-18,0	-	-	-	Ti ≥ 7 x % C ≤ 1,20	-
1.4511	X 6 CrNb 17 (X3CrNb17)	≤ 0,08	1,00	1,00	0,045	0,030	16,0-18,0	-	-	-	Nb ≥ 12 x % C ≤ 1,20 <sup>1)</sup>	-
1.4512	X 6 CrTi 12 (X2CrTi12)	≤ 0,08	1,00	1,00	0,040	0,015	10,5-12,5	-	-	-	Ti ≥ 6 x % C ≤ 1,00	-
1.4521	X2CrMoTi18-2	≤ 0,025	1,00	1,00	0,040	0,015	17,0-19,0	1,80-2,30	≤ 0,25	-	C+N ≤ 0,040; Ti ≥ 7(C+N) ≤ 0,80	-
1.4529	X1NiCrMoCuN25-20-6 (X1NiCrMoCuN25-20-7)	≤ 0,020	1,00	2,00	0,030	0,015	19,0-21,0	6,00-7,00	24,0-26,0	-	N 0,10-0,25; Cu 0,50-1,50	-
1.4535	X90CrCoMoV17	0,85-0,95	1,00	1,00	0,045	0,030	15,5-17,5	0,40-0,60	-	0,20-0,30	Co 1,20-1,80	-
1.4539	X1NiCrMoCuN25-20-5	≤ 0,020	0,70	2,00	0,030	0,015	19,0-21,0	4,00-5,00	24,0-26,0	-	N 0,04-0,15; Cu 1,00-2,00	-
1.4541	X6CrNiTi18-10	≤ 0,08	1,00	2,00	0,045	0,030	17,0-19,0	- <sup>3)</sup>	9,00-12,0	-	Ti ≥ (5 x % C) ≤ 0,80	-
1.4542	X 5 CrNiCuNb 17 4 (X5CrNiCuNb16-4)	≤ 0,07	1,00	1,00	0,045	0,030	15,0-17,0	-	3,00-5,00	-	Cu 3,00-5,00; Nb 0,15-0,45	-
1.4550	X6CrNiNb18-10	≤ 0,08	1,00	2,00	0,045	0,030	17,0-19,0	- <sup>3)</sup>	9,00-12,0	-	Nb ≥ 10 x % C ≤ 1,00 <sup>1)</sup>	-
1.4563	X 1 NiCrMoCuN 31 27 4 (X1NiCrMoCu31-27-4)	≤ 0,020	0,70	2,00	0,020	0,015	26,0-28,0	3,00-4,00	30,0-32,0	-	N 0,04-0,15; Cu 0,80-1,50	-
1.4571	X6CrNiMoTi17-12-2	≤ 0,08	1,00	2,00	0,045	0,030	16,5-18,5	2,00-2,50	10,5-13,5	-	Ti ≥ 5 x % C ≤ 0,80	-
1.4572	X10CrNiMoTi18-12	≤ 0,10	1,00	2,00	0,045	0,030	16,5-18,5	2,50-3,00	12,0-14,5	-	Ti ≥ 5 x % C	-
1.4575	X1CrNiMoNb28-4-2	≤ 0,015	1,00	1,00	0,025	0,015	26,0-30,0	1,80-2,50	3,00-4,50	-	Nb ≥ 12 x % C ≤ 1,20; N ≤ 0,035; C+N ≤ 0,040	-
1.4577	X3CrNiMoTi25-25	≤ 0,04	0,50	2,00	0,030	0,015	24,0-26,0	2,00-2,50	24,0-26,0	-	Ti ≥ 10 x % C ≤ 0,60	-
1.4580	X6CrNiMoNb17-12-2	≤ 0,08	1,00	2,00	0,045	0,030	16,5-18,5	2,00-2,50	10,5-13,5	-	Nb ≥ 10 x % C ≤ 1,00 <sup>1)</sup>	-
1.4582	X4CrNiMoNb25-7	≤ 0,06	1,00	2,00	0,045	0,030	24,0-26,0	1,30-2,00	6,50-7,50	-	Nb ≥ 10 x % C <sup>1)</sup>	-
1.4583	X10CrNiMoNb18-12	≤ 0,10	1,00	2,00	0,045	0,030	16,5-18,5	2,50-3,00	12,0-14,5	-	Nb ≥ 8 x % C <sup>1)</sup>	-
1.4586	X5NiCrMoCuNb22-18	≤ 0,07	1,00	2,00	0,045	0,030	16,5-18,5	3,00-3,50	21,5-23,5	-	Cu 1,50-2,00; Nb ≥ 8 x % C <sup>1)</sup>	-

1) Nb + Ta

2) Langerzeugnisse - Produits long - Long products S ≤ 0,030

3) Nach Vereinbarung - Selon convention - By agreement

<sup>1)</sup> Nb + Ta

<sup>2)</sup> Langerzeugnisse - Produits long - Long products S ≤ 0,030

<sup>3)</sup> Nach Vereinbarung - Selon convention - By agreement